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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,262	10/11/2000	Abraham S. Farag	04860.P2525X	1362

7590

05/22/2002

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EXAMINER

NGUYEN, JENNIFER T

ART UNIT

PAPER NUMBER

2674

DATE MAILED: 05/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/687,262

Applicant(s)

FARAG ET AL.

Examiner

Jennifer T Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No.6, 373,470 (Andre) in view of Pejic et al. (U.S. Patent No. 5,956,018).

Regarding claim 1, referring to figure 2, Andre teaches a computer mouse comprising: a base member; a top member pivotally coupled to said base member; wherein said top member forms an integral housing and button (see claim 1 of Andre, col. 4, lines 6-22).

Andre differs from claim 1 in that he does not specifically teach the base member having hold regions and the top member having a main surface configured to leave said hold regions substantially exposed. However, Pejic teaches base member having hold regions (30) and the top member having a main surface configured to leave said hold regions (30) substantially exposed (see figure 1D, col. 2, lines 19-20 and col. 5, lines 24-27, and lines 31-34).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the base member having hold regions and the top member

having a main surface configured to leave said hold regions substantially exposed as taught by Pejic in the system of Andre in order to provide more comfortable mouse usage for a variety of users and allow a user to continue a click and drag operation by lifting and repositioning the mouse while maintaining the mouse button in a clicked position.

Regarding claim 2, Andre further teaches the computer mouse, wherein said top member does not include a separate button (see claim 1 of Andre, col. 4, lines 8-10).

Regarding claims 3 and 4, the combination of Andre and Pejic teaches the computer mouse, wherein said hold regions (30) allow said top member to be maintained in a clicked position when the computer mouse is removed from a surface and said hold regions are substantially flush with said main surface of said top member (see figure 1D of Pejic, and lines 1-2 and 10-13 of abstract section).

Regarding claims 5 and 8, it would have been obvious to obtain the hold regions comprise first and second vertically extending tabs located on opposite sides of the base member in order to provide a mouse that may be used easily by users having different hand sizes or different degree of coordination.

Regarding claim 6, it would have been obvious to obtain the first and second vertically extending tabs are integrally formed with the base member in order to reduce the size, weight and the cost of the device.

Regarding claim 7, it would have been obvious to obtain the top member comprises first and second opening shaped to accommodate said first and second vertically extending tabs, respectively in order to provide a mouse that may be used easily by users having different hand sizes or different degree of coordination.

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Regarding claim 9, referring to figure 2, Andre further teaches a computer mouse having a button is a top housing of the computer mouse (see claim 1 of Andre, col. 4, lines 6-22).

Andre differs from claim 1 in that he does not specifically teach a first side ear and a second side ear wherein said first and second side ears are concurrently graspable to lift the computer mouse while maintaining a button of the computer mouse in a depressed position. However, Pejic teaches a computer mouse comprising a first side ear (30) a second side ear (30) wherein said first and second side ears are concurrently graspable to lift the computer mouse while maintaining a button of the computer mouse in a depressed position (col. 5, lines 31-34).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the first side ear and a second side ear wherein said first and second side ears are concurrently graspable to lift the computer mouse while maintaining a button of the computer mouse in a depressed position as taught by Pejic in the system of Andre in order to provide a space saving or make available additional space in computer system.

Regarding claims 10 and 11, it would have been obvious to obtain the first and second side ears are substantially rigid and first and second side ears are capable of accommodating a user's thumb and one of a user's other fingers in order to provide user more comfortable and easy for lift the device to hold and use it in space or to grip the device and use it while on a supporting surface.

Regarding claims 12 and 13, the combination of Andre and Pejic teaches the computer mouse wherein said first and second side ears (30) extend from a base and said first and second side ears (30) are located on opposite sides of said base (see figure 1D of Pejic).

Regarding claim 14, Andre further teaches a computer mouse comprising: a depressible housing coupled to said base such that said base is covered by said housing (see col. 4 of Andre, lines 6-22).

Andre differs from claim 14 in that he does not specifically teach a base having a first fixed portion and a second fixed portion wherein said first and second fixed portions are accessible through said depressible housing when said depressible housing is depressed.

However, Pejic teaches a base having a first fixed portion (30) and a second fixed portion (30) wherein said first and second fixed portions are accessible through said depressible housing when said depressible housing is depressed (col. 2, lines 19-20 and col. 5, lines 24-27, and lines 31-34).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the first fixed portion and the second fixed portion wherein said first and second fixed portions are accessible through said depressible housing when said depressible housing is depressed as taught by Pejic in the system of Andre in order to provide more comfortable mouse usage for a variety of users and allow user to continue a click and drag operation by lifting and repositioning the mouse while maintaining the mouse button in a clicked position.

Regarding claim 15, Andre further teaches the computer mouse, wherein not all of said depressible housing is depressible (see col. 4 of Andre, lines 8-23).

Regarding claim 16, the combination of Andre and Pejic teaches the computer mouse

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wherein said first and second fixed portions (figure 1D of Pejic) and said depressible housing are capable of being held concurrently to lift the computer mouse off a surface (col. 5, lines 31-34 of Pejic).

3. The prior art made of record and not relied upon is considered to pertinent applicant's disclosure.

Rudell et al. (U.S. Patent No. 6,200,219) teach toy vehicles with integral motion sensitive game display.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jennifer T. Nguyen** whose telephone number is **703-305-3225**.

The examiner can normally be reached on Mon-Fri from 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Richard A Hjerpe** can be reach at **703-305-4709**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC. 20231

Or faxed to: 703-872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, sixth-floor (Receptionist).


Any inquiry of a general nature or relating to the status of this application or proceeding

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should be directed to the Technology Center 2600 Customer Service Office whose telephone number is 703-306-0377.

Jennifer T. Nguyen
Patent Examiner
Art Unit 2674


ULKA J. CHAUHAN
PRIMARY EXAMINER